

REMARKS

It is respectfully requested that the present Amendment be entered into the Official File in view of the fact that the Amendment automatically places the application in condition for allowance. Thus, the present Amendment is believed to be in proper form for placing the application in condition for allowance.

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims and the following remarks.

Status of the Claims

In the present Amendment, claims 9, 24, 25, 28, 30, 32-34, 36-39 and 42-44 have been canceled, and claims 23 and 25 have been amended. Thus claims 23, 26, 27, 29, 31 and 35 are pending in this application.

No new matter has been added with the present amendments. The amendment to claim 23 actually deletes subject matter. The dependency of claim 35 has been appropriately changed.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. 112, First Paragraph

Claims 9, 23-39 and 42-44 stand rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the written description and enablement requirements (see Office Action, pages 2-6). Applicants respectfully traverse.

There appears to be several outstanding issues.

First, the Examiner is stating that the present specification does not support the claim language “determining that the candidate antidiabetic substance has a pharmacological action similar to that of the thiazolidine derivative.” Also, the Examiner states that the present specification does not disclose a determination step *per se*, (Office Action, page 4, first paragraph) and that the interaction itself between the candidate substance and protein is the determination that is not a separate step (Office Action, page 4, second paragraph).

Second, the Examiner states that the present specification does not disclose binding between SEQ. ID. NO.:2 and derivatives thereof with rosiglitazone, troglitazone or ciglitazone (Office Action, page 4, third paragraph).

Third, the Examiner states that although the specification discloses the structures for compounds A-1, A-2 and A-3, the specification does not disclose the antidiabetic properties, or even the pharmacological actions of these compounds as being similar to pioglitazone, rosiglitazone, troglitazone or ciglitazone (Office Action, page 4, fourth paragraph).

Fourth, the Examiner is rejecting target protein (b) (derivatives of SEQ. ID. NO.:2) of claims 9 and 44 since the present specification does not describe any examples of such derivatives having certain structures with the described antidiabetic properties (Office Action, page 6, first and second full paragraphs).

Regarding the first issue, claim 9 has been canceled. Regarding claim 23, Applicants respectfully disagree and request reconsideration based on the amendment to claim 23 as shown herein.

“The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention on any ground is always upon the examiner.” *Ex parte Parks*, 30 USPQ2d 1234, 1236 (citing *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992)); *see also In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). Also, the proper perspective for this issue under § 112, first paragraph, is from one having skill in the art. In fact, an exact, verbatim description is not necessary. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991); *see also Eiselstein v Frank*, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (“the ‘written description’ requirement with respect to later-filed claims, the prior application need not describe the claimed subject matter in exactly the same terms as used in the claims”; citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116; *see also In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976) (“[L]ack of literal support . . . is not enough . . . to support a rejection under Section 112.”).

Here, one skilled in the art would recognize that the present inventors possessed the claimed invention at the time of filing. At the very least, the present specification and state of the art inherently supports a determination step, especially given the description at page 15, lines 21-24 of Applicants’ specification.

Still, at pages 4-5 of the Office Action, the Examiner asserts that US 2008/0102457 does not mention that substances that bind to FLJ14797 (corresponding to SEQ ID NO:2 of the present application) are an antidiabetic compound. However, Applicants respectfully submit that

US '457 is being misunderstood or misconstrued. Specifically, the US '457 reference merely discloses that ketanserin or 5-hydroxytryptamine receptor antagonists binds to FLJ14797 (disclosed as SEQ ID NO: 16, corresponding to SEQ ID NO: 2 of the present application). Applicants understand that from the present application and the US '457 reference that FLJ14797 is not only a target of an antidiabetic compound, but also that of an antihypertensive drug.

Further, Applicants respectfully refer the Examiner to page 14, lines 20-21 of the present specification. According to this description, one of skill in the art can fully understand the role of FLJ14797 in diabetes. Again, the proper perspective for this issue under § 112, first paragraph, is from one having skill in the art. Thus, Applicants respectfully submit that this first issue has been resolved or overcome.

Regarding the second to fourth issues, Applicants note that claim 23 is directed to pioglitazone. Also, claims 9, 24, 25, 28, 30, 32-34, 36-39 and 42-44 have been canceled. Thus, these issues have been overcome and/or rendered moot.

Based on the above and for reasons of record, reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez, Reg. No. 48,501,

Application No. 10/569,791

Docket No.: 1254-0305PUS1

Art Unit 1647

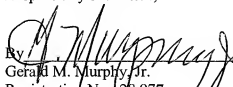
After Final Office Action of November 3, 2009

at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: February 3, 2010

Respectfully submitted,



Gerald M. Murphy, Jr.

Registration No.: 28,977

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road, Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant